

### **REMARKS**

Claims 1-15 and 27-29 have been rejected. Claims 16-26 have been withdrawn from consideration and have been cancelled by the previous amendment. Claims 1, 2, 8, 9, 12, and 28 have been currently amended. Claims 27 and 29 have been cancelled. Claims 1-15 and 28 are, therefore, presently pending in the application. Favorable reconsideration of the application in view of the following remarks is respectfully requested.

Claims 1-15 and 27-29 have been rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner states that the specification fails to provide support for the previous amendments. In particular, the Examiner objects to the language “instead of” to convey that at least one of the visibly colored images (corresponding to the blue, green and red exposures) in the element is replaced by an image based on infrared image formation. This fact, which is plainly the heart of the invention, is now conveyed by the conventional use of “consisting essentially of” in the claims. Thus, when the image in a color unit forms an image essentially by an infrared dye or coupler, that means in effect that this infrared dye or coupler has (as in the Examples) “replaced” the conventional use of a colored dye or coupler forming the image.

Claims 1-7 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that the language in claim 1 “(w)herein at least one image recording layer in the image recording layer units comprises an infrared dye-forming coupler instead of a colored dye-forming coupler for recording the blue, green or red exposure” is unclear as to what couplers are used for recording the blue, green or red exposure, i.e. infrared dye-forming coupler or colored dye forming coupler.

To clarify, an infrared-dye forming coupler is used for recording the exposure in the claimed element (in at least one recording unit). The image recording layer units are *sensitive* to a color, but the image formed by *recording* this color is an infrared dye. Thus a visible color (forming the exposure) is translated into a non-visible, i.e., hue (recording the image).

Claims 1-7, 11-14, 27-29 have been rejected under 35 U.S.C. §102(a) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over JP4-86658 (JP'658). The Examiner states that JP'658 discloses a heat developable color photosensitive material containing a dye providing substance and an infrared dye forming coupler.

This rejection is respectfully traversed. It is necessary, according to the present invention, that the infrared dye is an image forming dye responsive to a blue, green or red exposure in a photographic film. Infrared (IR) dyes and IR couplers are well known in the art for non-image forming purposes such as forming a movie soundtrack. The references do not disclose the use of an IR coupler for forming one of the three color images in a photographic film.

Thus, Applicants have found significant advantage for the color combination used in the present invention, in which an IR dye is used as one of three image dyes, the other two being, for example, magenta and yellow.

Further patentable aspects of the invention (claim 28) relate to a color photothermographic film comprising an incorporated developer in the imaging layers. The invention is particularly advantageous for use in a photothermographic film element that is scanned, in which scanning occurs before removing any silver halide from the film.

In summary, the present element covers an element that, on development, comprises essentially three basic image dyes corresponding to three different hues, one of which is an infrared dye. Thus, it is possible, for example in one embodiment, to use two colored dyes and an infrared dye or, in another embodiment, one colored dye and two infrared (far and near), but not three colored dyes as in JP '658. In contrast to the present invention, JP'658 forms an infrared dye in addition to cyan, magenta, and yellow. The infrared dye in JP '658 has not replaced one of the three colored image dyes, as in the present invention and as shown in the examples.

Claims 13-15 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Kato as applied to claims 1-7, 11-14 above, and further in view of Bohan et al ('470). The Examiner states that Bohan, in column 11, discloses that overall, the limited Dmin and tone scale density enabled by controlling the quantity of incorporated masking coupler, incorporated permanent Dmin adjusting dyes and support

optical density can both limit scanning noise and improve the overall signal-to-noise characteristic of the film to be scanned. The Examiner states that it would have been obvious to include the color masking coupler, permanent Dmin adjusting dyes and the optical density in the material of Kato to limit scanning noise and improve the overall signal-to-noise characteristic of the film to be scanned.

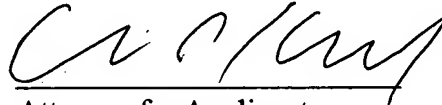
This rejection is traversed for the reasons stated above in the first rejection, since claims 13 to 15 depend from claim 1.

Claims 1-15 and 27-29 have been provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-15, 27-28 of copending Application No. 09/855,046. This is a provisional double patenting rejection.

The amendments to the above claims are believed to obviate this rejection.

The Examiner is respectfully requested to withdraw the outstanding rejection and to pass the subject application to Allowance.

Respectfully submitted,



Attorney for Applicants  
Registration No. 30,721

Chris P. Konkol/jec  
Rochester, NY 14650  
Telephone: (585) 722-0452  
Facsimile: (585) 477-1148